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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,663	10/24/2003	Anjali Abhimanyu Patil	Rev 02-26	9947

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Revlon Consumer Products Corporation
Law Department
237 Park Avenue
New York, NY 10017

EXAMINER

MERCIER, MELISSA S

ART UNIT	PAPER NUMBER
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1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/692,663

Applicant(s)

PATIL ET AL.

Examiner

Melissa S. Mercier

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 4-8 and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-22 and 27-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3-10-06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 4-8 and 23-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 26, 2006. Upon further consideration, the examiner has withdrawn the election of species requirement regarding Identification of X and Y.

Specification

The attempt to incorporate subject matter into this application by reference to Silicone Compounds (Silicones), Bruce B. Hardman, Arnold Torkelson, General Electric Company, Kirk-Othermer Encyclopedia of Chemical Technology, Volume 20, 3rd edition, pages 922-962, 1982 is ineffective because only US Patents and US Patent documents can be incorporated by reference into the specification.

Claim Objections

Claim 3 is objected to because of the following informalities: Claim 3 as presented is dependent on Claim 3. This appears to be a typographical error. Examination of Claim 3 was preformed on it being dependent on Claim 2. Appropriate correction is required.

Claim 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12. When two claims in an application are duplicates or else are so close in

content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. § 112; first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

M.P.E.P. § 2163 states, "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention...one must define a compound by 'whatever characteristics sufficiently distinguish it'. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process."

While the specification describes a species of the instantly claimed acrylic acid and methacrylic acid at p. 10, lines 15-18, which discloses "the ethylenically unsaturated

Art Unit: 1615

monomers may include repeating C₁₋₃₀ alkylenes, such as ethylene, propylene, butylene, and the like; as well as acrylic acid, methacrylic acid, either alone or esterified with C₁₋₃₀ alkanols; styrene, vinyl pyrrolidone, amides, urethanes, and the like, it does not describe a sufficient number of species as to convey possession of the entire genus encompassed by their simple esters.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 provides for the use of the composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper

Art Unit: 1615

definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

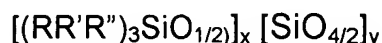
Claims 1-3, 9-18, 20-22, 27, 29-32, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Sandewicz et al (US Patent 6,451,329).

Sandewicz discloses, "a cosmetic composition and method for use on dry, normal, oily, or combination skin types. The resulting composition and method reduces the shiny appearance of oily skin and cosmetically improves the appearance of skin imperfections such as wrinkles, fine lines, and blemishes. The applied cosmetic provides a smooth, natural finish on skin" (column 2, lines 16-22). Ingredients for use in the composition are disclosed to comprise "one or more types of oils that may be volatile, non-volatile or mixtures thereof, including silicones, cyclic silicones, linear volatile silicones, straight or branched chain paraffinic hydrocarbons having about 5-40 carbon atoms, isododecane is disclosed. Additionally, non-volatile silicone oils such as dimethicone can be used" (column 3, lines 9-63). Suitable nonvolatile silicones include water insoluble silicones having a viscosity of about 10 to 600,000 centistokes at 25

Art Unit: 1615

degrees (column 3, lines 65-68). Further, organic oils including esters may be used. These oils have preferred viscosity ranges of 10-1000 at 25 degrees C (column 4, lines 25-35).

Sandewicz further discloses, "synthetic polymeric film formers with the general formula:



wherein R, R' and R'' are each independently a C₁₋₁₀ straight or branched chain alkyl or phenyl, and x and y are such that the ratio of (RR'R'')₃ SiO_{1/2} units to SiO₂ units is 0.5 to 1 to 1.5 to 1. In the preferred embodiments of Sandewicz, R, R' and R'' are methyl. The most preferred embodiment discloses triemethysiloxy silicate containing hydroxyl groups" (column 9, line 64 to column 10, line 25).

Sandewicz further discloses "silicone elastomers suitable for use as finishing enhancers, including cetearyl dimethicone/vinyl dimethicone cross polymer, dimethicone copolyol cross polymer, dimethicone cross polymer, dimethicone/phenyldimethicone cross polymer, dimethicone/vinyl dimethicone cross polymer, and mixtures thereof" (column 11, lines 17-24).

Sandewicz discloses the composition can further comprise pigments, used to provide color, whiteness, opacity, sunscreen activity, or be capable of muting color, including titanium dioxide, zinc oxide; bismuth oxychloride, titanated mica, fumed silica, iron oxides such as black, red, green, yellow, and organic pigments including various aromatic types such as azo, indigoid, triphenylmethane, anthraquinone, and xanthine dyes which are designated as D&C and FD&C blues, browns, greens, oranges, reds,

Art Unit: 1615

yellows, etc. Organic pigments also generally consist of insoluble metallic salts of certified color additives, referred to as the Lakes" (column 4, line 36 through column 5, line 5).

Regarding Claim 20, the recitation of "the composition of claim 1 which is a lipstick" is interpreted to be intended use and not given patentable weight. The composition is not further limited to distinguish it from any other cosmetic application.

Claims 1-3, 9-22, 27-29, and 32-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Vatter et al. (US Patent 6,475,500).

Vatter discloses, " an anhydrous skin treatment composition which includes a cross linked siloxane elastomer gel of specific yield point, a skin conditioning agent and a volatile siloxane" (abstract). Organopolysiloxane compositions include dimethicone/vinyl dimethicone cross polymers (column 6, lines 50-53).

"The solvent for the cross linked siloxane elastomer can be organic, silicone-containing, fluorine-containing, volatile or non-volatile, polar or non-polar, provided that the solvent forms a solution with the elastomer" (column 8, lines 24-50). Examples of non-polar solvents are disclosed to include isododecane and cyclomethicone (column 9, line 28 and 58-60) and paraffinic hydrocarbon oils (column 10, lines 63-64).

The composition of Vatter further comprises pigments. Useful pigments include "inorganic powders such as gums, chalk, Fuller's earth, kaolin, sericite, muscovite, phlogopite, synthetic mica, lepidolite, biotite, lithia mica; organic powder such as polyamide resin powder (nylon powder), cyclodextrin, methyl polymethacrylate powder,

Art Unit: 1615

copolymer powder of styrene and acrylic acid, benzoguanamine resin powder; and inorganic white pigments such as magnesium oxide" (column 13, lines 1-13).

Vatter further discloses suitable film forming agents include organic silicone resins, such as trimethylsiloxysilicate; and acrylic and methacrylic polymers and resins, including silicone-acrylate type copolymers (column 16, lines 4-18).

Vatter additionally discloses the use of solidifying agents including bentonites (column 19, line 21) and organic sunscreens (column 21, line through column 23, line 46).

Conclusion

No claims are allowable. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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